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JAN 16 2009

In re Application of :
Matsuo, et al. :
Application No. 10/568,505 : DECISION ON PETITION
Filed: February 16, 2006 :
Attorney Docket No. 108421-00127 :
For: CATALYST FOR CLARIFYING
EXHAUST GAS AND METHOD FOR
PREPARATION THEREOF, AND
EXHAUST GAS CLARIFICATION
CATALYST DEVICE FOR VEHICLE

This is a decision on the petition under 37 CFR 1.182, filed November 21, 2008, to withdraw two terminal disclaimers filed on April 29, 2008 in the above-identified application.

The petition under 37 CFR 1.182 is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." Petitioners are advised that this is not a final agency decision.

Petitioners request that the terminal disclaimers, filed April 29, 2008, in response to the rejections based on obviousness-type double patenting made in the January 29, 2008 non-final Office action be withdrawn. Petitioners assert the aforementioned terminal disclaimers were "entered inadvertently." Petitioners have not demonstrated that the circumstances of this application warrant the relief requested.

Inspection of the prosecution history of the instant application reveals that the terminal disclaimers were submitted to overcome rejections for obviousness-type double patenting over the several claims of U.S. Patent Application No. 11/032,233 and U.S. Patent No. 7,199,079. Petitioners assert that the terminal disclaimers were entered inadvertently. However, the first paragraph of page 7 of the remarks filed with amendment on April 29, 2008 clearly indicates applicants were intending to file the terminal disclaimers in order to overcome the obviousness-type double patenting rejections by the examiner. The filing of the terminal disclaimers was not a simple mistake.

It appears that petitioners are seeking to reopen the question of the propriety of the rejections made in the Office action of January 29, 2008. In essence, petitioners are attempting, by petition, to have the Office

determine whether the double patenting rejections were proper. MPEP 1490 sets forth in pertinent part, “Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered.”

It is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between petitionable and appealable subject matter. MPEP 1201. When the question of whether or not a given set of claims in one application or patent is distinct, or lies within the aegis of 35 U.S.C. 121, from another set of claims in another application or patent with respect to obviousness-type double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). As noted by the court in In re Faust, 378 F.2d 966, 153 USPQ 813 (CCPA 1967) “the terminal disclaimer eliminates the necessity of considering what are most often exceedingly difficult questions. i.e., whether the subject matter of the appealed claims is obvious in view of the patent claims relied on as the basis for ‘double patenting,’ thus conserving judicial man hours both here and in the Patent Office.” Further, it is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

Even assuming, *arguendo*, the relief requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief requested in this petition is given favorable consideration. In this regard, an applicant’s use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). It is brought to petitioners’ attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). While petitioners may now consider the previously filed disclaimers to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as “an unhappy circumstance”, rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Petitioners had the opportunity to challenge the need for a terminal disclaimer, on appeal, but instead freely chose to file a terminal disclaimer to avoid the rejection. Moreover, petitioners have provided no explanation as to why filing of the terminal disclaimers, as opposed to contesting the propriety of the rejection, was caused or contributed to by circumstances beyond petitioners’ control. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free dedication to the public contained in the previously filed terminal disclaimers by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff’d. No. 84-1357 (Fed. Cir. June 14, 1985).

Petitioners may wish to take note of MPEP 1490 which states in part, “The filing of a continuation application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.”

The file is being forwarded to Technology Center 1793 for consideration of the amendment filed on November 21, 2008.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

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